

Application Serial No.: 10/027,902
Sub. Amendment and Response Dated August 12, 2004

PATENT
3596.02-2

REMARKS

Applicant's New Statement for this Substitute Amendment

Applicants earlier cancelled claims 1-29 and replaced them with now pending claims 30-59. The combustible fuel in the independent claims is now a list of specific liquid fuels. Also ethylene oxide condensation and ethylene oxide esterification products are excluded from these compositions. The remaining claims as amended are similar to the claims now allowed by this Examiner in the parent application now issued as U.S. Patent 6,348,074. Claims 50 to 59 are narrow ranges for specific fuels and are fully supported in the originally filed application. See for example in the specification

for description and definition of fuels other than diesel fuel
at page 21, lines 17-23;
for reference to fuel to additive ratios of between 50:50 to 99:1;
at page 13, lines 31-33 through page 14, lines 1-19 - specifically line 19;
at page 15, lines 16-33 through page 16, lines 1-4 - specifically lines 12-15;
at page 17, lines 1-25, specifically line 25;
at page 32, lines 1-35, page 33, lines 1-5, specifically lines 3-5; and
at page 33, lines 7-35, page 34, lines 1-9, specifically lines 6-8.

Applicants have made the amendments suggested by the Examiner.
No new matter has been added to this application.

EXAMINER'S STATEMENT

The Examiner states:

"Applicant's election of Claims 1-28 in the paper filed February 2, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467,

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114 USPQ 330 (CCPA 1957); and *In re Vogeli*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 33-39 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-10 of prior U.S. Patent No. 6,348,074. This is a double patenting rejection."

Applicants respectfully traverse this rejection.

Applicant has amended Claims 30-59 as suggested by the Examiner. Claims 4 to 10 of USP 6,348,074 are for diesel fuel. These claims in this application do not include diesel fuel.

Therefore all these rejections have been overcome.

Reconsideration and withdrawal of these rejections is respectfully requested.

REJECTION OF CLAIMS 30-32 AND 40-59 UNDER 35 U.S.C. 112

Originally filed claims 30-32 and 40-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that:

"The independent claims, claims 30, 40 and 46 are directed to fuel compositions containing combustible liquid fuel and an additive wherein the combustible liquid fuel is "selected from the group consisting of" or "selected from" "kerosene, heating oil, coal slurry and distilled vegetable oil", yet the claims also recited "the additive when combined with mixing with diesel fuel". Numerous depend claims also make reference to diesel fuel. Accordingly, it is unclear what the claimed composition contains.

Claims 40 and 46 contain improper Markush language, i.e., claims 40 and 46 improperly recite "selected from" as opposed to "selected from the group consisting of". Accordingly, it is unclear if the claims are restricted to the recited elements of the "group" or whether the claim may contain other, non-recited liquid fuels.

In claim 57, the term "such as vegetable oil" is indefinite. (It is noted that claim 30, from which claim 57 depends, recite "distilled vegetable oil").

Claims 30-32 and 40-59 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action."

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Applicant respectfully traverses this rejection.

Applicant has amended the prior Claims 1-29 by cancelling those claims and has presented amended Claims 30-59. These claims recite vegetable oils as the combustible fuel source. The remainder of the claims are similar to the claims allowed by the USPTO in the parent application, U.S. 6,348,074.

With these amendments Applicants argue that the Examiner's concerns have been overcome and the now pending claims are of a form and scope for allowance.

Applicant plans to file shortly an amendment in copending U.S. Ser. No. 10,078,820. This planned amendment will focus the claims on diesel fuel and will expressly include the ethylene oxide condensation and ethylene oxide condensation and ethylene oxide esterification products as part of the composition.

Applicant believes these amendment will serve to sufficiently distinguish the claims of U.S. 6,348,074, U.S. Ser. No. 10,027,902 and U.S. Ser. No. 10/078,820 so that a terminal disclaimer is not needed.

Applicant requests that if the Examiner disagrees, that he call for the submission of a terminal disclaimer.

Prompt notification thereof is respectfully requested.

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SUMMARY

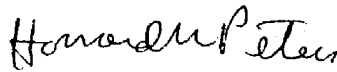
Applicants assert these claims are now of a form and scope for allowance.

A petition for Extension of Time is enclosed.

If additional fees are required for the filing of this document, the Commissioner for Patents is hereby authorized to charge or credit overpayment to Deposit Account No. 16-1331.

Respectfully submitted,

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Enclosure: Combined Notice of Appeal from the Primary Examiner to the Board of Patent
Appeals and Interferences & Petition for Extension of Time Under 37 CFR
1.136(a) (Small Entity)

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